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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,123	07/23/2001	Maurice Cuijpers	US018108	4460

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EXAMINER

BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 03/04/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/912,123

Applicant(s)

CUIJPERS ET AL.

Examiner

Raymond J. Bayerl

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-- The MAILING DATE of this c mmunication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 - 2, 6 - 7, 9 - 15, 17 is/are rejected.
- 7) ☒ Claim(s) 3 - 5, 8, 16, 18 - 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2, 4</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The abstract of the disclosure is objected to because the abbreviations "STB" and "FSR" would not be readily understood. The full-text spelling should appear at least once, in parentheses. Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities: please note the uncertainty at page 5, line 17 (paragraph [022]), where it appears that applicant meant "keypad **104**", instead of the indicated "keypad 108". Appropriate correction is required.
3. Claims 1 – 12 are objected to because of the following informalities: as noted above with respect to the abstract, the abbreviation "CE" should be accompanied by the full-text spelling, in claims 1, 2, 3, 4, 5, 6, 7, 8, 9. Also note: claim 2, "inputs [input?] keys"; claim 9, line 8, "one of the option [options?]" ; claim 10, line 3, "inputs [input?] keys". Appropriate correction is required.
4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 9 – 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A "software application...wherein: the application comprises: an input...an output...the application having..." (independent claim 9) is a computer program *per se*, since it is not positively fixed in a tangible medium, such as computer storage or hardware. This does not fit any of the four statutory classes of "process, machine, manufacture or composition of matter".

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 6 – 7, 9, 11, 13, 15, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schein et al. ("Schein"; US #6,075,575).

As per independent claim 1's "CE-system" having a "user feedback device" and "a user input device" (see also independent claim 9), Schein's REMOTE CONTROL DEVICE AND METHOD FOR USING TELEVISION SCHEDULE INFORMATION (thus teaching "a user input device") is used in conjunction with a television schedule information system that is displayed, for example, on the viewer's television screen (a "feedback device for rendering user-selectable options"; Abstract; see also fig 3). The remote control device of Schein allows the user to freely move a cursor in all directions on the television screen (col 2, lines 1 – 23).

Particularly relevant in Schein is the teaching regarding a local controller that permits scrolling vertically through a column of items and scrolling horizontally through row of items (col 2, lines 24 – 54). When taken in conjunction with Schein's global controller for navigating between different screen areas (col 2, line 55 – col 3, line 6), this anticipates a "coarse positioning user input means" (the global controller) and a "fine positioning means" (the local controller).

As per claim 6's "highlighted option to provide visual feedback to the user of the current navigation position" (see also claim 15), please note Schein's item that may be

automatically highlighted with a brighter color to indicate the viewer's location (col 8, line 62 – col 9, line 16). This highlighted cell is capable of “jumping”, as in claim 11. As in claim 7, when the Schein user arrives at a desired highlighted “option”, the viewer simply clicks on cylinder 24 (col 11, lines 23 – 56), to anticipate “an option selection means”. The “coarse positioning input means” of Schein's fig 2 (e.g., the 4 buttons in the outer ring) are “physically combined with” the “option selection means”, in that they are contained in the single fig 1 remote control.

Independent claim 13 is generally similar to independent claims 1, 9, which recite the “input” of “coarse” and “fine” “data for navigation”, and are anticipated by Schein's controller structure. When interpreted with reasonable breadth, “a first indicium” appears at one of the global navigation stages, to be replaced by “a second indicium” when the user has moved on to working within the local region.

As per independent claim 17, the “coarse positioning user input” and “fine positioning user input” read upon Schein, as noted above. In particular, the keypad, as shown in figs 1, 2, can be “conveniently operated by a user's thumb”.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2, 10, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein in view of Kim ("Kim"; US #5,910,798).

As per claims 2, 10, 14, while Schein provides a "fine positioning user input means" that has four directional inputs *per se*, in the form of the two buttons 34 and the cylinder 24, this does not **explicitly** teach a set of "four or more directional inputs [sic] keys", though applicant should note that the "coarse positioning" **is** achieved in this way by the outer buttons 22.

However, Kim's APPARATUS FOR MOVING A CURSOR ON A SCREEN, as shown in fig 2, has a set of four directional buttons 103b – 103e that operate together with "coarse positioning" obtained from the mouse 103. Specifically, fine movement buttons are formed to predetermined portions around the mouse button for moving a cursor upward, downward, left and right (Abstract; see also col 2, lines 27 – 44).

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to use 4 "fine positioning" keys as per Kim in the remote controller keypad of Schein, for this extends the concept of the "coarse positioning" keys

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in Schein to a single input syntax for “fine positioning”, which has significant user utility in learning the keystrokes in the 4 directions.

11. Claims 3 – 5, 8, 12, 16, 18 – 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Please also note that the rejection of claim 12, as being directed to a non-statutory invention under 35 USC 101, must also be overcome.

As per claim 3, in which “the fine positioning user input means is placed around the coarse positioning user input means”, the closest prior art, as noted above, is Schein. However, Schein fails to teach or suggest that the “fine” control buttons are “placed around the coarse” ones. Instead, the opposite is shown; fine buttons with the coarse buttons around **them**. Kim, on the other hand, merely shows 4 “fine positioning” input buttons, with no corresponding set of “coarse controls” in such an annular arrangement.

The details of claim 8, with “contact time discrimination in order to be able to distinguish between a coarse navigation input mode and a fine navigation input mode”, are also not fairly taught nor suggested by the prior art now made of record. While it is true that a time-based asynchronous sequence of button presses must be interpreted in Schein and Kim, this is not used for distinguishing the two modes of fine and coarse. A similar line of reasoning applies to claims 12, 16, 18.

Claim 19’s arrangement, having a “coarse positioning user input means” that “is spatially located between the fine positioning user input means and the option selection

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user input means", has further patentable distinction over the directional button layouts of Schein and Kim. Schein, as noted above, has the reverse spatial disposition, in which the "fine positioning user input means" is between the "coarse" and "option selection" portions of the remote control interface. Kim, as also noted previously, does not have the concentric arrangement of "coarse" and "fine" in a single keypad. A similar line of reasoning applies to claim 20's "fine position user input means" that "is centered around the coarse position user input means".


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The remaining US Patent documents made of record (see attached form PTO 892) pertain to various prior art techniques for directional cursor control.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (703) 305-9789. The examiner can normally be reached on M - F from 10:00 AM to 5:00 PM.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173
1 March 2004